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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 09/893,998 Confirmation No. : 5656  
Applicant : Franz CEMIC, *et al.*  
Filed : June 29, 2001  
TC/A.U. : 2872  
Examiner : Arnel C. LAVARIAS  
  
Docket No. : 2098L/49970  
Customer No. : 23911  
  
Title : ILLUMINATION DEVICE, AND COORDINATE MEASURING  
INSTRUMENT HAVING AN ILLUMINATION DEVICE

**Mail Stop PETITION**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PETITION REQUESTING WITHDRAWAL OF FINALITY OF OFFICE**  
**ACTION DATED OCTOBER 12, 2004**

Sir:

Applicant respectfully requests that the finality of the Office Action dated October 12, 2004 be withdrawn.

MPEP §706.07(a) provides that second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is not necessitated by applicant's amendment of the claims.

In the present application, the Office Action of October 12, 2004 was made final even though new grounds of rejection were introduced. The new ground of rejection was not necessitated by Applicant's amendment of the claims in the Amendment of July 29, 2004.

In the February 2, 2004 Amendment, Applicant added two new claims (*i.e.*, claims 9 and 10) (see pages 8 and 9).

Application No. 09/893,998  
Petition dated October 20, 2004  
Responsive to Office Action dated October 12, 2004

In the subsequent Office Action dated April 29, 2004, the Examiner failed to provide any ground for the rejection of claims 9 and 10.

In the Reply of July 29, 2004, Applicant pointed out that the Examiner did not provide any reason for the rejection of claims 9 and 10 (see pages 9 and 11). No amendments to claims 9 and 10 were made.

In the final Office Action of October 12, 2004, the Examiner, for the first time, provided the reasons why claims 9 and 10 were rejected (see page 4). These reasons, however, had never been provided before and clearly constituted new grounds of rejection. And the new grounds of rejection were not necessitated by any claim amendments, because claims 9 and 10 were not amended in the Reply of July 29, 2004. As a result, the rejection of claims 9 and 10 was made final, before Applicant even had an opportunity to address specifically the reasons for the rejection.

Consequently, the Office Action of October 12, 2004 has been improperly made final.

Please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (CAM #011270.49970US).

Respectfully submitted,

October 20, 2004

  
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